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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/508,369	06/14/2000	ERIC BARLOW	61512/CCD/RS	9882

7590 07/28/2003

COOPER & DUNHAM
1185 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

EXAMINER	
MCNEIL, JENNIFER C	

ART UNIT	PAPER NUMBER
1775	13

DATE MAILED: 07/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-13

Office Action Summary	Application No.	Applicant(s)	
	09/508,369	BARLOW ET AL.	
	Examiner	Art Unit	
	Jennifer McNeil	1775	

-- The MAILING DATE of this communication appears on the cover sheet with the corresp ndence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 April 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,9-11,13-16,18,19 and 21* is/are pending in the application.

4a) Of the above claim(s) *15,16,18,19 and 21* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,9-11,13,14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Objections

Claim 9 is objected to because of the following informalities: Lines 3 and 4, should the "adhesion promoter" be the –coating containing an adhesion promoter--?

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1- 4, 9- 11, 13, and 14 are rejected under 35 U.S.C. 103(a) as unpatentable over Matsuo et al (EP 426328A2). Matsuo et al teach coating a work article surface with an anodic oxide coating followed by a resin coating. The work article may comprise an aluminum plate (page 12, line 4), and the resin coating may comprise additives such as MoS_2 and SiO_2 (page 5). A subsequent cationic electrodeposition of paint is deposited on the resin coating (page 2, lines 23-26; page 3, lines 17-21; page 4, lines 37-42; page 4, line 47- page 5, line 15).

Matsuo does not specify the thickness of the anodic oxide layer or a weight of the adhesion promoter coating. Absent a showing of unexpected results, optimization of both of these values is considered within the purview of one of ordinary skill in the art, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art (*In re Aller*, 105 USPQ 233). Furthermore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the anodic oxide layer in a

thickness sufficient to protect the underlying substrate and also provide adhesion for the overlying layers.

Regarding the process of deposition of the layers , "[E]ven though product-by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.", *In re Thorpe*, 227 USPQ 964, 966. Once the Examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product, *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983), MPEP §2113. It is the position of the Examiner that the final product produced by the method limitations in the article claims would be commensurate with the article taught by Matsuo.

Regarding claim 3, the organic polymer is optional and therefore is not positively recited.

Claims 1-4, 10, 11, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Totsuka et al (US 5,395,687). Totsuka teaches a surface-treated aluminum material. The aluminum material is first coated with a chromate film, which may be deposited electrolytically (col. 8, lines 14-18). The chromate film is followed by an organic resin coating. The resin coating includes organic polymers and electroconductive finely divided particles such as Cr, and also may include a fluororesin. Totsuka teaches that the aluminum material may be used in automobiles (col. 7, lines 24-26). Totsuka teaches that the oxide film is deposited to a coating weight of 5-100 mg/m^2.

Totsuka does not specify the thickness of the anodic oxide layer. Absent a showing of unexpected results, optimization of the thickness is considered within the purview of one of ordinary

skill in the art, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art (*In re Aller*, 105 USPQ 233). Furthermore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the anodic oxide layer in a thickness sufficient to protect the underlying substrate and also provide adhesion for the overlying layers.

Regarding the process of deposition of the layers, "[E]ven though product-by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.", *In re Thorpe*, 227 USPQ 964, 966. Once the Examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product, *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983), MPEP §2113. It is the position of the Examiner that the final product produced by the method limitations in the article claims would be commensurate with the article taught by Totsuka.

Regarding claim 3, the organic polymer is optional and therefore is not positively recited

Response to Arguments

Applicant's amendments and arguments have overcome the rejections over Sugama '718, and Borresen '526. Applicant's amendments and arguments have also overcome the objection to the specification, and the 112 claim rejections.

Applicant's arguments filed April 23, 2003 regarding Matsuo and Totsuka have been fully considered but they are not persuasive

Applicant states that Matsuo teaches that a conversion coating and an anodic oxide coating are alternatives, and no suggestion that one should be employed over the other. Applicant also states that the resin coating of Matsuo is not a conversion coating, and that the inorganic ions are there for different reasons. Applicant also states that electron microscope pictures show the two films present after the complete treatment. Matsuo clearly teaches that the chromate pretreatment may be performed by anodically oxidizing the substrate (page 4, lines 37-42). As stated above, the process steps for forming the coatings are not considered to limit the final structure of the article. The specification and references of record do not teach that anodic or no-rinse depositions provide a structurally different article.

Applicant argues that Totsuka does not teach anodization. As stated above, Totsuka teaches that the chromate film may be deposited electrolytically (col. 8, lines 14-18).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer McNeil whose telephone number is 703-305-0553. The examiner can normally be reached on Monday through Friday, 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on 703-308-3822. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Jennifer McNeil
Examiner
Art Unit 1775

JCM
July 24, 2003

ROBERT R. KOEHLER
PRIMARY EXAMINER
ART UNIT 1775